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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,805	04/12/2001	Akira Arai	9319A-000203	1939

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EXAMINER	
SHEEHAN, JOHN P	

ART UNIT	PAPER NUMBER
1742	11

DATE MAILED: 09/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D

Office Action Summary	Application No. 09/833,805	Applicant(s) ARAI ET AL.	
	Examiner John P. Sheehan	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *19-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4&5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1 to 18 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the inventions are so related to each other that an undue burden would not be placed on the Examiner by maintaining both groups of claims in a single application. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Further, to examine both sets of claims in the same application would require not only additional searching but also would require consideration of additional 112 issues, prior art, formulation of rejections, etc.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

4. Claims 1 to 18 provide for the use of a cooling roll (see claim 1, line7), but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

The claims although implying how the cooling roll is used do not clearly and explicitly recite exactly how the cooling roll is used.

Claims 1 to 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

5. Claims 3, 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claims 3, 5 and 6, the metes and bounds of the term "around room temperature" (claim 3, lines 3 and4; claim 5, line 3 and claim 6, line 3). What temperatures are considered to be "around" and not "around" room temperature?

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1 to 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Croat (US Patent No. 4,851,058, cited by the applicants in the IDS submitted August 31, 2001).

Croat teaches a method of making a magnetic material having a composition that overlaps the alloy composition recited in the instant claims (column 2, lines 15 to 30). Croat's method comprises melt spinning (column 4, lines 18 to 58), that is, "a molten alloy is collided to a circumferential surface of a cooling wheel to be cooled and solidified" (applicants' claim 1, lines 2 and 3).

Croat and the claimed process differ in that Croat does not teach the presence of "gas expelling means" (applicants' claims 1, line 8) as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because it is well settled that where the prior art teaches the process sought to be patented, a difference in the structure of the apparatus used to carry out the process, or any of its steps, cannot be considered as a patentable limitation therein -- particularly when the apparatus, as in the instant case, is the crux or heart of the invention, In re Sweeney, 72 USPQ 501 and Stalego and Drummond v Heymes and Peyches 120 USPQ 473 (CCPA 1959).

8. Claims 1 to 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funkuno et al. (Funkuno, US Patent No. 5,665,177, cited by the applicants in the IDS submitted July 30,2001).

Funkuno teaches a method of making rare earth-iron-boron permanent alloy powder (Column 1, lines 25 to 29; column 5, lines 45 to 50 and column 17, lines 58 to 60) by ejecting a melt of the alloy against a cooling roll (column 3, lines 3 to 14 and column 9, line 37 to 50) wherein the cooling roll has grooves with a pitch of 100 to 700 um (column 5, lines 54 to 61) to form a ribbon that is ground to a particle size of 30 to 700 um (column 8, lines 18 to 23). The grooves have an average depth of 1 to 50 um (column 6, lines 26 to 28). The roll in Funkuno's process is a base roll with an outer surface layer having a thermal conductivity that is less than that of the base roll and in which the grooves are formed (column 6, line 65 to column 7, line 6).

The claims and Funkuno differ in that Funkuno does not teach the exact same cooling roll characteristics.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because where the claimed ranges overlap the prior art a prima facie case of obviousness exists, MPEP 2144.05.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 17 of copending Application No. 09/871,592. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed process in each of these two sets of claims overlap. Both sets of claims are directed to a method of making a magnetic material having the same composition, by a process of melt spinning, that is, "a molten alloy is collided to a circumferential surface of a cooling wheel to be cooled and solidified". The instant claims recite the presence of "gas expelling means" while the claims in 09/871, 592 recite the presence of "dimple correcting means". However, each of these terms encompasses the presence of grooves on the cooling rolls. Accordingly, these two sets of claims are considered to overlap. In view of this overlap, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because where the claims overlap a prima facie case of obviousness exists, MPEP 2144.05.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

John P. Sheehan
Primary Examiner
Art Unit 1742

jps
September 22, 2002